

McConathy, Evelyn H.

From: McConathy, Evelyn H.
Sent: Tuesday, September 07, 2010 3:43 PM
To: Bart Classen
Subject: RE: Appeal decision

Bart:

An oral hearing was requested in the March 27, 2008 filing and the fees were paid for the Oral Hearing. However, the current rules state that a separate paper must be filed.

1209 Oral Hearing [R-3]
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37 CFR 41.47 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as appeals decided after an oral hearing.

(b) If appellant desires an oral hearing, appellant must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months from the date of the examiner's answer or supplemental examiner's answer.

(c) If no request and fee for oral hearing have been timely filed by appellant as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs without an oral hearing.

(d) If appellant has complied with all the requirements of paragraph (b) of this section, a date for the oral hearing will be set, and due notice thereof given to appellant. If an oral hearing is held, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. A hearing will be held as stated in the notice, and oral argument will ordinarily be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered.

In this case, I filed a Response to the Examiner's Answer, several Declarations AND the separate Request for Oral Hearing on August 1, 2008. But here is the problem. Although filed in hard copy (which is how we did it in 2008) with a post card (I have copies of all papers), we never received the postcard back and it never appears on PAIR. As a result, the Appeal Branch said no Response was filed, and no Request was made for oral Hearing (the \$515.00 having already been paid). I knew this problem existed at the PTO, and we made numerous phone calls in the Fall of 2008, but no one could find the filing at the PTO. Then you said that you wanted the case pulled back into prosecution, so I stopped fighting with the PTO, since none of that would have mattered in prosecution. In 2009 there was no urgency, but certainly by 2010, the case had to be moved -and soon. It would have been moved in July, before the Decision. But then work on this case stopped.

Given that a Rehearing is possible, it seems to me that a Continuation is still permitted, because during Rehearing it would be permitted. But I need to check on that with the head of the Appeal Branch. The bigger problem to me is why wasn't there an Oral Hearing since the fees were collected by the PTO and the papers were properly filed. This will take some sorting out at this point and I will contact Robert Bahr for assistance, as I have done on the Reexams. And I will do so today to ask him what alternative are available, and then I will get back to you.

Evelyn

-----Original Message-----

From: Bart Classen [mailto:cclassen@vaccines.net]
Sent: Tuesday, September 07, 2010 1:01 PM

EXHIBIT L